

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the matter of:

Reexamination of U.S. 6,265,196

Inventor: S. Chandrasegaran

Control No: 90/008,526

Art Unit: 3991

Examiner: Sharon Turner

Atty. Docket No: 2240-243505

Customer No:

26694

PATENT TRADEMARK OFFICE

REQUEST FOR INTERVIEW PURSUANT TO 37 C.F.R. § 1.560

Mail Stop: EX PARTE REEXAM

Central Reexamination Unit

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.560, Patentee requests an Examiner Interview to discuss the issues set forth in the Final Office Action mailed May 5, 2010.

In particular, Patentee requests the interview to discuss the priority claim. Inasmuch as the remaining two art rejections are both based on Kim et al. (1994) *Proc. Nat'l. Acad. Sci. USA* 91:883-887 (hereinafter "Kim"), the art rejections can only be sustained if, as asserted in the Final Office Action, Patentee is not entitled to the filing dates of priority application nos. 08/346,293, filed November 23, 1994 (now U.S. Patent No. 5,487,994) and 08/126,564, filed September 27, 1993 (now U.S. Patent No. 5,436,150), in addition to the priority of U.S. application no. 08/757,361, filed December 20, 1995 (now U.S. Patent No. 5,792,640), as acknowledged in the final Office Action.

priority of U.S. application no. 08/757,361, filed December 20, 1995 (now U.S. Patent No. 5,792,640), as acknowledged in the final Office Action.

Accordingly, in addition to the priority chart of record, Patentee requests the interview to present and discuss additional evidence regarding the priority claim, and to obtain clarification of the USPTO's position. Briefly, Patentee again notes that the cited reference (Kim) is co-authored by the inventor of the instant application, Dr.

Chandrasegaran. The results presented in Kim, which the Examiner states in the Final Office Action show inactivation of a target DNA using a chimeric Ubx-FokI nuclease, are presented in priority application no. 08/126,564, filed September 27, 1993 (now U.S. Patent No. 5,436,150).

The '564 application, as well as the Kim publication, are incorporated by reference into subsequent application 08/346,293, filed November 23, 1994, which issued as U.S. Patent No. 5,487,994 (see col. 1, lines 4-12, col. 10, lines 41-43, and col. 11, lines 7-8):

The subject application is a continuation-in-part of application Ser. No. 08/126,564, filed Sept. 27, 1993, which has been allowed and is, in turn, a continuation-in-part of application Ser. No. 08/017,493, filed on Feb. 12, 1993, which has been abandoned and is, in turn, a continuation-in-part of application Ser. No. 07/862,831, which was filed on Apr. 3, 1992 and which issued as U.S. Pat. No. 5,356,802. All three parent continuation-in-part applications are hereby incorporated in their entirety by reference and relied upon.

...

The following scientific article have been cited throughout the present application and are hereby incorporated by reference in their entirety and relied upon:

...

(15) Kim, Y-G., and Chandrasegaran, S. (1994) Proc. Natl. Acad. Sci. U.S.A. 91:883-887.

Furthermore, priority application no. 08/757,361, filed December 20, 1995 (now U.S. Patent No. 5,792,640), incorporates by reference the full disclosure both of priority

To further probe the linker region, the present inventor constructed several insertion and deletion mutants of FokI endonuclease. A detailed description of the process for making and using and the properties of these mutants are disclosed in U.S. patent application Ser. No. 08/346,293, allowed, the entire contents of which are hereby incorporated by reference and relied upon.

The following scientific article have been cited throughout the present application and are hereby incorporated by reference in their entirety and relied upon:

...
8. Kim, Y.-G. & Chandrasegaran, S., Proc. Natl. Acad. Sci. U.S.A. 91: 883-887, 1994.
....

Therefore, Patentee submits that it is entitled to the priority dates of application no. 08/757,361, filed December 20, 1995 (now U.S. Patent No. 5,792,640), application no. 08/346,293, filed November 23, 1994 (now U.S. Patent No. 5,487,994) and application no. 08/126,564, filed September 27, 1993 (now U.S. Patent No. 5,436,150). As such, Kim is not available as a reference and the pending claims are allowable.

It is respectfully requested that an Examiner Interview be granted in order to discuss this issue.

A copy of this response is being served on the Third Party Requester, per the Certificate of Service attached hereto.

Respectfully submitted,

Date: June 8, 2010

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of this paper is being served on the Requester,

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

via overnight delivery service on the date shown below.

Date: June 8, 2010



Ann S. Hobbs, Ph.D., J.D.